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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,316	10/30/2001	Joseph A. Zupanick	067083.0162	9338

5073            7590            03/24/2003

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[REDACTED] EXAMINER

STEPHENSON, DANIEL P

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3672

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/004,316	ZUPANICK, JOSEPH A.	
	Examiner	Art Unit	
	Daniel P Stephenson	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 03 October 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8 and 18-28 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 15 February 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5-7,10</u> .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8 and 18-28, drawn to a method for accessing a subterranean zone, classified in class 175, subclass 61.
  - II. Claims 9-17, drawn to a guide tube and method for its use, classified in class 175, subclass 80.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as a whipstock.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Terry Stalford on 3/11/03 a provisional election was made without traverse to prosecute the invention of group I, claims 1-8 and 18-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 26 and 28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. New matter was put forth in claims 26 and 28 when they recited “conducting fluid to the...”, the specification is silent with regards to putting fluid into the wellbore.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 7, 18-22 and 25-28 rejected under 35 U.S.C. 102(b) as being anticipated by Ohmer '059. Ohmer '059 (Figures 14A-14D, col. 17 lines 14-23) discloses using multiple wellbores set at an angle to an entry wellbore to access a subterranean zone. Three wellbores may be used, set at 120 degree angles to the entry wellbore, as shown in Fig. 14A. These secondary wellbores are then split laterally in the subterranean zone by horizontal wellbores. These horizontal wellbores form a drainage pattern within the subterranean zone for removing valuable material. The valuable material is then pumped to the surface through the system.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohmer '059. Ohmer '059 discloses all the limitations of the claimed invention as stated previously, however Ohmer'059 does not explicity recite that the drainage pattern covers an area of at least 640 acres. It is notoriously conventional within the wellbore art to install a pattern of wells that allows for the removal of any area of land. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the drainage pattern of Ohmer '059 over an area of at least 640 acres.

11. Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohmer '059 in view of Dickenson et al. '734. Ohmer '059 discloses all the limitations of the claimed invention as stated previously, however Ohmer'059 does not explicity recite that there is an enlarged cavity formed in each of the slanted wellbores proximate to the subterranean zone. Dickenson et al. '734 (Figure 1, col. 4 line 14-col. 9 line 41) discloses a method of drilling a lateral borehole from a vertical one in which a space is formed at the base of the borehole so that a turning apparatus may shift the drilling apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the cavity based turning apparatus of Dickenson et al. '734 at the base of the borehole of Ohmer '059. This would be

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done so that a more reliable method of turning a flexible tube, whether it is a drainage tube or a drilling tube could be utilized.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P Stephenson whose telephone number is (703) 605-4969. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1020.

Daniel P Stephenson  
Examiner  
Art Unit 3672

DPS *gbs*  
March 18, 2003

*David Bagnell*  
DAVID BAGNELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600